

REMARKS

The Office Action of March 24, 2011 has been received and reviewed. This response, submitted along with a Petition for a One-Month Extension of Time, is directed to that action.

Claims 60-62 are new. Support for these claims can be found in the specification on page 6, line 34 to page 7, line 4. No new matter has been added.

The applicants respectfully request reconsideration in view of the foregoing amendments to the claims and the following remarks.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 1-15, 19-21, 23, 27-45 and 48-59 under 35 U.S.C. §103(a) as obvious over Lang et al. (US 3,162,575) in view of Duffy et al. (US 3,826,232), Hagerty (US 5,094,853), Emerson (US 6,124,275) and Greene (US 4,473,582). The applicants respectfully traverse this rejection.

The presently claimed invention is directed to a solid stick insecticidal composition comprising a base, an insecticide and at least 60 wt% food material, wherein the composition has penetration hardness of from 0.1 to 5mm. Lang, on the other hand, is directed to method for controlling face flies on livestock, comprising applying to the face of livestock an insecticide stick for flies having 40-80 wt.% microcrystalline wax base mixed with 10-60 wt.% petroleum oil, up to 50 wt.% particulate sugar and 0.25 to 1.5 wt.% insecticide. Lang is silent with respect to the penetration hardness, but the Examiner stated that the when "the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise". (Office Action, page 11).

A *prima facie* case of obviousness cannot be established because the prior art references fail to teach or suggest all of the claimed elements. Furthermore, a skilled artisan would not be motivated to modify Lang to achieve the present invention.

As stated hereinabove, the insecticide of the present invention has a penetration hardness between 0.1 and 5 mm. The Examiner expects that Lang's composition would exhibit a penetration hardness within the claimed range, but the data contained in the applicant's specification proves otherwise. In particular, Example 3 on pages 27 and 28 of the specification compared a composition according to the present invention against a composition according to Lang, which formulation was obtained directly from Lang's specification. The data reported indicates that the composition according to the present invention exhibited an average penetration hardness of 2.12mm. Contrarily, the composition of Lang exhibited a penetration hardness of 5.59mm, far outside the claimed range. Accordingly, Lang does not teach all of the limitations of the presently claimed invention. Furthermore, there is nothing in any of the other references to suggest a similar composition that would have a penetration hardness within the presently claimed range.

Even still, a skilled artisan would not be motivated to modify Lang to lower the penetration hardness within the claimed range because doing so could render Lang unsuitable for its intended use. Indeed, it is well-established law that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In order to lower the penetration hardness in Lang, a skilled artisan would have to lower the amount of microcrystalline wax in the formulation to below at least the required 40 wt.%. However, a high wax content (40-80 wt.%) is necessary in order for Lang's composition

to maintain its position on the animal's face without migrating into the eyes or mouth of the animal. ("By virtue of the wax carrier and oily constituent, the material applied to the face of the animal remains in the position where the same is initially placed and does not migrate towards the animals eyes, nose or mouth" Lang, col. 2, lines 54-58). A high hardness keeps the composition from migrating away from the original area of placement. Lowering the penetration hardness would therefore increase the likelihood of migration, thereby rendering Lang unsuitable for its intended use.

Based on the foregoing remarks, the applicants respectfully submit that a *prima facie* case of obviousness cannot be established, and respectfully request that the Examiner withdraw this rejection.

The applicants believe that the claimed invention is now in condition for allowance, and respectfully request such favorable action. If any issues remain, the resolution of which can be advanced through a telephone conference, the Examiner is invited to contact the applicant's attorney at the phone number listed below.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By /Mark D. Marin/

Mark D. Marin
Reg. No. 50,842
875 Third Avenue, 8th Floor
New York, NY 10022
Tel. 212-808-0700